

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL A. FIRESTONE

Appeal No. 2005-2370
Application No. 09/635,624

HEARD: OCTOBER 20, 2005

MAILED

JAN 11 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, JERRY SMITH, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 11, 13, 15, 16, 18, 20, 22, 23, 25 and 26. Claims 1-10, 12, 14, 17, 19, 21 and 24 have been canceled.

We affirm.

BACKGROUND

Appellant's invention is directed to a method of collecting fees associated with vehicles for road usage wherein every vehicle contains a unique identification code readable by a scanner. According to Appellant, the identification code is used

for collecting fees, identifying vehicles and their regulatory compliance (specification, pages 5-6). An understanding of the invention can be derived from a reading of exemplary independent claim 11, which is reproduced below:

11. A method for collecting vehicular road use fees comprising:

- (a) issuing a mandatory unique vehicle identifier to a vehicle by a governmental central agency that issues a vehicular registration;
- (b) inputting information concerning said vehicle to said central agency;
- (c) establishing an account at said central agency for said vehicle to pay for road use fees;
- (d) attaching said unique vehicle identifier to said vehicle;
- (e) reading said vehicle identifier with a mobile reader when said vehicle is stationary and reading said vehicle identifier with a stationary reader when said vehicle is moving to retrieve said vehicle identifier from said vehicle;
- (f) communicating said vehicle identifier to said central agency;
- (g) charging said account with a road use fee; and
- (h) communicating said information in said central agency to said mobile and stationary reader.

The Examiner relies on the following prior art references:

Leitner et al. (Leitner)	5,587,575	Dec. 24, 1996
Urbish et al. (Urbish)	5,734,343	Mar. 31, 1998
Slavin et al. (Slavin)	5,819,234	Oct. 6, 1998

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Claims 11, 13, 15, 16, 18, 20, 22, 23, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Urbish, Slavin and Leitner.

We make reference to the briefs and answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

In rejecting the claims, the examiner relies on Urbish for teaching an identification label for a vehicle that is read at a toll booth without the need for the vehicle to slow down or stop at the booth (answer, page 3). The Examiner further relies on Slavin for providing a transponder for communicating from a service center the information related to an account established in connection with the vehicle identification tag (answer, page 4). Relying on Leitner for teaching a portable scanner for reading the tag and retrieving the vehicle information, the Examiner concludes that using such portable scanner allows reading the vehicle information from a tag in situations where a fixed reader is not available (id.).

Appellant argues that because Leitner provides for a stand-alone unit, no active communication with a center is performed to deliver the "real-time" status information regarding the vehicle to the identification tag (brief, page 8). Appellant further points out that neither Urbish, nor Slavin cures the deficiency of Leitner as they lack any teachings related to a two-way system of reading a vehicle identifier using a mobile reader and sending the information back to the reader in real time (brief, page 9). Appellant also adds that according to the invention the information concerning the vehicle identifier is issued by a governmental agency that has access to information concerning the vehicle (brief, page 10). Thus, Appellant concludes that what distinguishes Appellant's invention from the prior art is the coordination between governmental agency and the reader in the toll booth and the communication of the vehicle information to the reader (brief, paragraph bridging pages 10 & 11).

In response to Appellant's arguments, the Examiner asserts that the toll plaza computer of Slavin does communicate with a centrally located computer to send information from the identification tag and to receive updates on the credit balance associated with a vehicle account (answer, page 5). The Examiner

further points out that the mobile reader of Leitner is used when the vehicle is stationary to read the vehicle information from a label as taught by Urbish (answer, page 6). With respect to the entity issuing the label, the Examiner argues that the label taught by Urbish contains the vehicle identification number in relation to a vehicular registration which is issued by a governmental central agency (id.).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the

question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). However, the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

From our review of Urbish, Slavin and Leitner, we find that the references are all concerned with reading the vehicle information from an identification tag or label. Urbish teaches the use of an optical label on a vehicle which contains, for example, the vehicle identification number and is scanned for toll collection (col. 4, lines 17-28) without the need for the vehicle to slow down (col. 4, lines 46-53). Slavin, similarly pertains to automated toll collection wherein an identification

tag attached to a vehicle is scanned and the toll amount is subtracted from a pre-paid toll credit account set up for the vehicle at a central location and linked to the tag (col. 5, lines 53-60). Thus, contrary to Appellant's assertion that communicating information concerning the vehicle from the central agency to the reader is absent in Slavin (brief, page 10), the identification information of the vehicle is communicated to the central computer which, in turn, updates the credit balance in the local computer associated with the tag reader.

We also note that Leitner was specifically relied on for teaching a mobile reader for reading the identification information from a vehicle tag. Although we agree with Appellant that Leitner does not mention collecting road use fees based on the information read (reply brief, page 4), to the extent that a portable scanner is used for collecting the vehicle identification information from a tag, the reference teachings provide added flexibility and mobility to the toll collection system of Urbish and Slavin in other road use fee collections.

We also remain unconvinced by Appellant's argument (reply brief, page 3) that the information communicated from the central agency in Slavin relates to a credit card and not to a vehicle.

In that regard, Slavin specifies that the tag number broadcast by the transponder tag is associated with a toll account number of a vehicle (col. 5, lines 49-51). The fact that Slavin communicates information associated with the toll credit account does not preclude reading the claimed "information concerning said vehicle" and "communicating said information" on such toll account corresponding to a specific vehicle. This information includes vehicle ID, credit card, account balance, etc., which, although may also relate to the user of the vehicle, correspond to a vehicle identified with unique tag where all concern that specific vehicle. Therefore, we remain unpersuaded by Appellant's arguments that any error in the Examiner's determination regarding the obviousness of the claimed subject matter has occurred. Accordingly, as the Examiner has established a prima facie case of obviousness with respect to claim 11, we sustain the 35 U.S.C. § 103(a) rejection of claim 11, as well as claims 13, 15, 16, 18, 20, 22, 23, 25 and 26, argued as one group and stated as falling together (brief, page 4), over Urbish, Slavin and Leitner.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 11, 13, 15, 16, 18, 20, 22, 23, 25 and 26 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
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Jerry Smith
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